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JAN 13 2004

Paper No. 10

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SMITH & HOPEN PA  
15950 BAY VISTA DRIVE  
SUITE 220  
CLEARWATER FL 33760

In re Application of: WILLIAM A. DODD

Application No.: 10/065,467

Filed: October 22, 2002

For: FLEET MAINTENANCE METHOD

) DECISION ON RENEWED PETITION  
 ) FOR ACCELERATED  
 ) EXAMINATION UNDER M.P.E.P.  
 ) §708.02(VIII)

This is a decision on the petition, filed June 18, 2003 under 37 C.F.R. §1.102(d) and M.P.E.P. §708.02(VIII)--Accelerated Examination, to make the above-identified application special, supplemented by the renewed petition filed November 10, 2003 and Petitioner's Request for Reconsideration filed December 05, 2003.

The petition is DENIED.

#### BACKGROUND

A review of the file record reveals that:

1. Petitioner filed a Petition on June 18, 2003 to make the above-identified application special under 37 C.F.R. §1.102(d) and M.P.E.P. §708.02(VIII). The Petition was dismissed because Petitioner's submission was deficient: Petitioner's statement "[t]he discussion and comments that follow are not intended to defend the patentability of the referenced patent application..." does not comply with M.P.E.P. §708.02(VIII)(E), which requires that the submission point out how the claimed subject matter is patentable over the references.
2. Petitioner's Renewed Petition filed November 10, 2003, although complying with the Decision on Petition mailed August 26, 2003 by omitting the deficient language, was dismissed by the Decision on the Renewed Petition mailed November 19, 2003 because it did not comply with items (D) and (E) of M.P.E.P. §708.02(VIII): (1) Petitioner did not submit a detailed discussion of the references deemed most closely related to the subject matter encompassed by the claims; and (2) Petitioner's discussion did not "point out, with the particularity required by 37 CFR 1.111(b) and (c), how the claimed subject matter is patentable over the references."
3. Petitioner, on December 05, 2003, filed the instant Request for Reconsideration.

#### OPINION

The relevant portions of the Patent Rules and Regulations are reproduced as follows:

## 37 CFR § 1.111

...

(b) In order to be entitled to reconsideration or further examination, the applicant or patent owner must reply to the Office action. The reply by the applicant or patent owner must be reduced to a writing which distinctly and specifically points out the supposed errors in the examiner's action and must reply to every ground of objection and rejection in the prior Office action. *The reply must present arguments pointing out the specific distinctions believed to render the claims, including any newly presented claims, patentable over any applied references.* If the reply is with respect to an application, a request may be made that objections or requirements as to form not necessary to further consideration of the claims be held in abeyance until allowable subject matter is indicated. The applicant's or patent owner's reply must appear throughout to be a bona fide attempt to advance the application or the reexamination proceeding to final action. *A general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references does not comply with the requirements of this section* (emphasis added).

(c) In amending in reply to a rejection of claims in an application or patent under reexamination, *the applicant or patent owner must clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made.* The applicant or patent owner must also show how the amendments avoid such references or objections (emphasis added).

M.P.E.P. §708.02, Section VIII which sets out the prerequisites for a grantable petition for Accelerated Examination under 37 C.F.R. §1.102(d) states in relevant parts:

A new application (one which has not received any examination by the examiner) may be granted special status provided that applicant (and this term includes applicant's attorney or agent) complies with each of the following items:

- (A) Submits a petition to make special accompanied by the fee set forth in 37 CFR 1.17(h);
- (B) Presents all claims directed to a single invention, or if the Office determines that all the claims presented are not obviously directed to a single invention, will make an election without traverse as a prerequisite to the grant of special status.
- (C) Submits a statement(s) that a pre - examination search was made, listing the field of search by class and subclass, publication, Chemical Abstracts, foreign patents, etc. A search made by a foreign patent office satisfies this requirement;
- (D) Submits one copy each of the references **deemed most closely related to the subject matter encompassed by the claims** if said references are not already of record; and
- (E) Submits a **detailed discussion** of the references, which discussion points out, with the **particularity** required by 37 CFR 1.111(b) and (c), **how the claimed subject matter is patentable over the references** (emphasis added).

Petitioner, in the Request for Reconsideration filed December 05, 2003, argues that (1) “[a]lthough the Office is correct in the recitation regarding the brief discussion of certain references, it is important to note that brief discussions are pertained only to those references deemed to be immaterial to patentability” and “the inclusion of a brief discussion of immaterial references in no way creates a deficiency under the Patent rules;” and (2) that “37 CFR 1.111(c) is inapplicable as it is pertains only to ‘amending in reply to a rejection of claims in an application or patent under reexamination’,” and “37 CFR 1.111(b) only requires the reply to present arguments pointing out the specific distinctions believed to render the claims patentable over any applied references. There is no requirement for a limitation by limitation distinction.”

As to Petitioner's first argument, although Petitioner's statement “the inclusion of a brief discussion of immaterial references in no way creates a deficiency under the Patent rules” is reasonable, it is not applicable in the case at bar wherein Petitioner states “[t]here is submitted herewith a copy of the **references deemed most closely related** to the subject matter encompassed by the claims.” See Petition dated June 18, 2003 (p. 3) and the Renew Petition dated November 10, 2003 (p.7). Petitioner also attached Form PTO-1449 and copy of those references. Because all references submitted are admitted by Petitioner as “**most closely related**

to the subject matter encompassed by the claims,” a detailed discussion of these references is required.

Petitioner’s second argument states that “37 CFR 1.111(c) is inapplicable ...” and “37 CFR 1.111(b) only requires the reply to present arguments pointing out the specific distinctions believed to render the claims patentable over any applied references. There is no requirement for a limitation by limitation distinction” This argument is not persuasive. M.P.E.P. § 708.02(VIII)(E) clearly requires Petitioner to comply with 37 CFR 1.111(b) and (c): Petitioner “[s]ubmits a detailed discussion of the references, which discussion points out, with the particularity required by 37 CFR 1.111(b) and (c), how the claimed subject matter is patentable over the references” (emphasis added). One way for pointing out, “with the particularity required by 37 CFR 1.111(b) and (c), how the claimed subject matter is patentable over the references ” is to compare the references with the subject matter of the claims, at least of the independent claims, limitation by limitation. Another way is to discuss whether the references anticipate the claims (*i.e.*, the references teach or disclose all the claim limitations) (emphasis added). Still another way is to discuss whether or not the claims are obviously patentable over the references.

In the instant petition,

(1) Petitioner does not submit a detailed discussion of the references deemed most closely related to the subject matter encompassed by the claims.

(2) Petitioner’s discussion does not point out, “with the particularity required by 37 CFR 1.111(b) and (c), how the claimed subject matter is patentable over the references.” Petitioner does not compare the references with the claimed subject matter. Instead, Petitioner compares the references with subject matter which is not claimed. For example, Petitioner states that “the ‘729 patent does not describe a method for comparing sales and usage data claimed by the present application”: This method for comparing sales and usage data is not claimed, at least not in the independent claim 1. With respect to other references, such as US application publication No. US 2002/01614 A1 and the ‘242 publication, the same way of discussion is submitted: Comparison of the references with subject matter which is not claimed, at least with respect to the independent claim 1.

Accordingly, the Petition is DENIED. The application file is being forwarded to Central Files to await examination in its proper turn based on its effective filing date.



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